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PPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
09/902,789	07/12/2001	David John Smith	1708.0100000/JMC/AES	6639	
26111 7.	590 12/17/2003		EXAMINER		
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W.			BARTS, SAMUEL A		
WASHINGTO			ART UNIT	PAPER NUMBER	
			1621		

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

			A li ti							
Office Action Summary			Application	n No.	Applicant(s)					
			09/902,789	)	SMITH ET AL.					
	omee Action Guimiary		Examiner		Art Unit					
	The MAN INC BATE COL		Samuel A E	l l	1621					
Period fo	The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply									
THE   - Exte after   - If the   - If NC   - Failu   - Any	ORTENED STATUTORY PERIOD MAILING DATE OF THIS COMMUI nsions of time may be available under the provision SIX (6) MONTHS from the mailing date of this complete period for reply specified above, the maximum restoreply within the set or extended period for repreply received by the Office later than three months and patent term adjustment. See 37 CFR 1.704(b).	NICATION. ns of 37 CFR 1,136 nmunication. (30) days, a reply v statutory period wil	86(a). In no even within the statuto ill apply and will of cause the applic	t, however, may a reply be time ory minimum of thirty (30) days expire SIX (6) MONTHS from the ation to become ABANDONED	oly filed  will be considered timely.  ie mailing date of this communication  (35.U.S.C. 8.133)	on.				
	Responsive to communication(s) fi	iled on 02 Sec	entember 20	03						
	Responsive to communication(s) filed on <u>02 September 2003</u> .  This action is <b>FINAL</b> . 2b) This action is non-final.									
Dispositi	on of Claims			,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,,	. 0.0. 210.					
4)⊠	☑ Claim(s) <u>1-36</u> is/are pending in the application.									
	4a) Of the above claim(s) <u>33,35,36 and 369</u> is/are withdrawn from consideration.									
5)[	5) Claim(s) is/are allowed.									
6)⊠	6)⊠ Claim(s) <u>1.3,5-8 and 34</u> is/are rejected.									
7)🖂	Claim(s) 2 and 4 is/are objected to	•								
8)□	8) Claim(s) are subject to restriction and/or election requirement.									
Applicati	on Papers									
9)[	The specification is objected to by t	he Examiner.								
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.										
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).										
-	Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).									
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.										
Priority u	nder 35 U.S.C. §§ 119 and 120				•					
a)[	Acknowledgment is made of a clair  All b) Some * c) None of:  1. Certified copies of the priority  2. Certified copies of the priority  3. Copies of the certified copies application from the Internation	documents of documents of the priority	have been have been to	received. received in Application ts have been received	n No					
13) <u> </u>	ee the attached detailed Office action cknowledgment is made of a claim note a specific reference was included CFR 1.78.	on for a list of for domestic	f the certifie priority und	d copies not received er 35 U.S.C. § 119(e)	(to a provisional applicati	on) eet.				
a) The translation of the foreign language provisional application has been received.										
14) <u></u> A re	cknowledgment is made of a claim ference was included in the first ser	for domestic ntence of the	priority und specificatio	er 35 U.S.C. §§ 120 a n or in an Application	nd/or 121 since a specific Data Sheet. 37 CFR 1.78	; 3.				
Attachment	(s)									
2) 🔲 Notice	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (I nation Disclosure Statement(s) (PTO-1449) F		5)	Interview Summary (P Description   Descripti	TO-413) Paper No(s) ent Application (PTO-152)					

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#### **DETAILED ACTION**

#### Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-8 and 34 in Paper filed September 02, 2003 is acknowledged. Applicant also elected the species of example 4. The traversal is on the ground(s) that searching the additional inventions would not be a burden to the Examiner. This is not found persuasive because art anticipating and/or rendering obvious one invention would not necessarily anticipate and or render obvious the other inventions. Thus the Examiner would have to continue searching. This additional searching and the reasonable possibility of divergent prosecution of the different inventions make the examination of these inventions a serious undue burden to the examiner. The examiner does recognize applicants right to have "method of use" and "process of making" claims rejoined with allowed compound claims. The requirement is still deemed proper and is therefore made FINAL.

<sup>&</sup>lt;sup>1</sup> The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on

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### Claim Rejections - 35 USC § 112

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2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
- 4. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note

Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation "alkyl", and the claim also recites "preferably methyl" which is the narrower statement of the range/limitation.

## Allowable Subject Matter

- 5. The elected species was found allowable. In accordance with the current office practice the search of the genus was extended to a point where patentability could be determined.
- 6. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
- 7. Claim 2 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 8. The following is a statement of reasons for the indication of allowable subject matter: The claimed subject matter of claims 2 and 4 are not suggested in the prior art of record.

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9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- 10. Claim1, 3, 5-8 and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Gmeiner et al (Chem. Abstract 1992:426035).

  Applicants claim the following genus:

Gmeiner disclosed the following compounds:

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These compounds read on the genus when; n=2 and  $R_{1-11}$  are hydrogen. Claim 34 reads on the compounds in any solution.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Samuel A Barts Primary Examiner Art Unit 1621 Page 6

s.b.